



GP 2872
41
5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 2053**

Yoshinori IKETAKI et al. : Atty Docket No. 2001-0327A

JUL 14 2004

Serial No. 09/814,125 : Group Art Unit 2872

TECH CENTER 1600/2900

Filed March 22, 2001 : Examiner Audrey Y. Chang

DOUBLE-RESONANCE-ABSORPTION
MICROSCOPE

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975

PATENT OFFICE FEE TRANSMITTAL FORM

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached hereto is a check in the amount of \$1060.00 to cover Patent Office fees relating to filing the following attached papers:

Petition for Extension of Time: \$950.00

Terminal Disclaimer: \$110.00

A duplicate copy of this paper is being submitted for use in the Accounting Division, Office of Finance.

The Commissioner is authorized to charge any deficiency or to credit any overpayment associated with this communication to Deposit Account No. 23-0975, with the EXCEPTION of deficiencies in fees for multiple dependent claims in new applications.

Respectfully submitted,

Yoshinori IKETAKI et al.

By

W. Douglas Hahm
Registration No. 44,142
Attorney for Applicants

WDH/gtg
WENDEROTH, LIND & PONACK, L.L.P.
2033 K St., N.W., Suite 800
Washington, D.C. 20006-1021
Telephone (202) 721-8200
July 6, 2004

[Check No. 62752]

2001_0327A



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 2053**
Yoshinori IKETAKI et al. : Docket No. 2001_0327A
Serial No. 09/814,125 : Group Art Unit 2872
Filed March 22, 2001 : Examiner Audrey Y. Chang

RECEIVED

JUL 14 2004

TECH CENTER 2890

DOUBLE-RESONANCE-ABSORPTION
MICROSCOPE

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In view of the following remarks, a Petition for a three-month extension of time being submitted concurrently herewith, reconsideration of the rejections set forth in the Office Action of January 5, 2004 is respectfully requested..

Claims 74 and 77-97 are presently pending in this application. On page 3 of the Office Action, the Examiner has set forth rejections of several of the pending claims. However, during a telephone conversation with the Examiner on January 9, 2004, the Examiner indicated that all of the pending claims, 74 and 77-97 have been rejected based on the grounds set forth on page 3 of the Office Action. Thus, the Examiner has rejected claims 74, and 77-97 under the judicially-created doctrine of obviousness-type double patenting, as being unpatentable over claims 1, 3, 6, 7, 44, 46, 49, 51, 62, and 63 of U.S. Patent 6,667,830 (the '830 Patent).

In order to overcome this double patenting rejection, a Terminal Disclaimer has been prepared and submitted herewith. However, the Applicants also note that in order for the Terminal Disclaimer to be effective, the ownership of the present application must be identical to the ownership of the '830 Patent. In this regard, it is noted that the '830 Patent is owned by Japanese

Science and Technology Corporation and Olympus Optical Co., Ltd. On the other hand, it is noted that the present application has been assigned to Japan Science and Technology Corporation, Olympus Optical Co., Ltd., *and* Nippon Roper KK. Therefore, in order to correct the ownership of the present application so that it is identical to the ownership of the '830 Patent, an Assignment has been prepared and submitted herewith for recordation in the USPTO, in which the share of the present application owned by Nippon Roper KK has been assigned to Olympus Optical Co., Ltd. Thus, it is submitted that the ownership of the present application is identical to the ownership of the '830 Patent, so that the Terminal Disclaimer is effective. Consequently, it is respectfully submitted that the Examiner's double patenting rejection has been overcome.

The Examiner has not set forth any additional rejections of pending claims 74 and 77-97 in the Office Action. Thus, because the Examiner's double patenting rejection has been overcome as explained above, it is respectfully submitted that claims 74 and 77-97 are now in condition for allowance.

The Examiner is also requested to note that a Notification of Assignment has been submitted herewith for recordation. In particular, the Notification of Assignment indicates that the share of both the present application and the '830 Patent owned by Japan Science and Technology Corporation has been assigned to Japan Science and Technology Agency. Because this second Assignment affects *both* the present application and the '830 Patent, it is submitted that the ownership of the present application is still identical to the ownership of the '830 Patent, so that the Terminal Disclaimer submitted herewith is effective.

In view of the above remarks, it is submitted that the present application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicant's undersigned representative.

Respectfully submitted,

Yoshinori IKETAKI et al.

By: 

W. Douglas Hahm
Registration No. 44,142
Attorney for Applicants

WDH/gtg
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
July 6, 2004